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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/809,545	03/14/2001	Lawrence W. Stanton	SCIOS.017A	5472

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EXAMINER

MARTINELL, JAMES

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 10/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/809,545

Applicant(s)

STANTON ET AL.

Examiner

James Martinell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-26 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7 and 20-26, drawn to nucleic acids, vectors, oligonucleotide arrays, nucleic acid hybridization assays, and kits, classified in class 536, subclass 23.1 and class 435, subclasses 320.1, 252.3, 325, 69.1, and 6.
- II. Claims 8-10, drawn to polypeptides and compositions containing polypeptides, classified in class 530, subclass 350.
- III. Claims 11-13, 17, and 23, drawn to antibodies, compositions containing antibodies, methods of treatment, and kits, classified in class 530, subclass 387.1.
- IV. Claims 14 and 15, drawn to agonists and antagonists of undisclosed nature and structure and compositions, classified in class unknown, subclass unknown.
- V. Claim 16, drawn to methods of treatment using an agonist or antagonist, classified in class unknown, subclass unknown.
- VI. Claims 18 and 19, drawn to a screening method, classified in class 435, subclass 7.1.

The inventions are distinct, each from the other because of the following reasons. The nucleic acids, vectors, and oligonucleotide arrays of Group I are materially different from and are therefore independent and distinct from the polypeptides of Group II, the antibodies of Group III and the agonists and antagonists of Group IV. The methods of Group I may be practiced independently of the methods of each of Groups III, V, and VI. The polypeptides of Group II are materially different from and are therefore independent and distinct from the antibodies of Group III and the agonists and antagonists of Group IV. The polypeptides of Group II are not needed to practice the methods of either one of Groups III or V. The polypeptides of Group II have uses other than in the methods of Group VI (*e.g.*, in affinity chromatography). The antibodies of Group III are materially different from and are therefore independent and distinct from the agonists and antagonists of Group IV. The antibodies of Group III are not needed to practice the methods of any of Groups IV-VI. The methods of Groups III, V, and VI may be practiced independently of one another. The agonists and antagonists of Group IV have uses other

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than those of Group V (*e.g.*, as poisons). The agonists and antagonists of Group IV are not need to practice the methods of Group VI.

Claim 23 appears in both Group I and Group III because it is drawn to two independent and distinct kits, one kit contains nucleic acids and the other contains antibodies. Should applicants elect either one of Groups I or III, applicants are further required to amend claim 23 so that it embraces only one type of kit invention.

Claims 1-7 and 20-26 are drawn to nucleotides, nucleotide constructs, and/or methods requiring the use of nucleotides or nucleotide constructs that contain more than ten individual, independent, and distinct nucleotide sequences in alternative form. Accordingly, these claims are subject to restriction under 35 U.S.C. § 121 as outlined in 1192 O.G. 68 (November 19, 1996). This notice permits the examination of from one to ten independent and distinct nucleotide sequences in a single application based upon USPTO resources.

Applicant is required to select no more than ONE of the individual sequences for examination. The search of the no more than ONE selected sequences may include the complements of the selected sequences and, where appropriate, may include subsequences within the selected sequences (*e.g.*, oligomeric probes and/or primers).

Claims 20-26 are drawn to compositions reciting different combinations of individual nucleotide sequences. Applicant is required to select one combination for examination. If the selected combination contains ten or fewer sequences, all of the sequences of the combination will be searched. If the selected combination contains more than ten sequences, the combination will be searched until one nucleotide sequence is found to be allowable. The order of searching will be chosen by the examiner to maximize the identification of an allowable sequence. If no individual nucleotide sequence is found to be allowable, the examiner will consider whether the combination of sequences taken as a whole renders the claims allowable. The identification of any allowable sequence(s) will cause all combinations containing the allowed sequence(s) to be allowed. See O.G. 68 (November 19, 1996). Likewise, claim 23 is drawn to a combination of antibodies. Applicant is required to select one combination for

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examination. If the selected combination contains ten or fewer sequences, all of the sequences of the combination will be searched. If the selected combination contains more than ten sequences, the combination will be searched until one nucleotide sequence is found to be allowable. The order of searching will be chosen by the examiner to maximize the identification of an allowable sequence. If no individual nucleotide sequence is found to be allowable, the examiner will consider whether the combination of sequences taken as a whole renders the claims allowable.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their different classification and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

To search any two groups as outlined above would create an undue burden for the U.S. PTO because the searches of the non-patent literature are not only non-overlapping to any appreciable extent, but are also divergent in nature.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Martinell whose telephone number is (703) 308-0296. The fax phone number for Examiner Martinell's desktop workstation is (703) 746-5162. The examiner works a flexible schedule and can be reached by phone and voice mail. Alternatively, a request for a return telephone call may be e-mailed to james.martinell@uspto.gov. Since e-mail communications may not be secure, it is suggested that information in such requests be limited to name, phone number, and the best time to return the call.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on (703) 305-4028. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



James Martinell, Ph.D.
Primary Examiner
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